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In re Application of :  
HATA et al. :  
Application No.: 10/538,776 :  
PCT No.: PCT/JP04/00055 :  
Int. Filing Date: 08 January 2004 :  
Priority Date: 09 January 2003 :  
Attorney Docket No.: ASAIN0164 :  
For: GRADIENT STRUCTURE MATERIAL :  
AND FUNCTIONAL ELEMENT USING :  
THE SAME :

DECISION ON  
PAPERS UNDER 37 CFR 1.42

This decision is issued in response to the declaration filed 10 June 2005 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

**BACKGROUND**

On 08 January 2004, applicants filed the above-identified international application which claimed a priority date of 09 January 2003. Pursuant to 37 CFR 1.495, the deadline for payment of the basic national fee was to expire 30 months from the priority date, 09 July 2005.

On 10 June 2005, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee; a copy of the international application; an English translation of the international application; and a declaration executed by Tomonobu Hata, Kimihiro Sasaki and the legal representative on behalf of deceased inventor Shinichi Morita.

**DISCUSSION**

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

The declaration filed on 10 June 2005 is executed by Tomonobu Hata, Kimihiro Sasaki and what appears to be "Kimiko Morita" as the "legal representative" of the

deceased inventor, Shinichi Morita. The declaration submitted appears to have been executed by the proper parties under 37 CFR 1.42, however, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide name, residence, citizenship, and post office address for the legal representative. In this case, the declaration filed on 10 June 2005 provides the residence, citizenship, and post office address for only one individual and it is unclear whether this information is for the legal representative or the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

### CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

Applicants are required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTHS** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should be addressed to: Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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